

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Applicant: Robert B. Hope
Serial No.: 10/033,518
Filed: December 28, 2001
For: WEATHER SEAL HAVING ELASTOMERIC MATERIALS
ENCAPSULATING A BENDABLE CORE

Examiner: Jerry E. Redman Art Unit: 3634

Atty. Docket: ULB-003CV

APPEAL BRIEF

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GROUP 3600

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Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicant respectfully submits the following brief in support of his appeal of the Final Rejection of Claims 1-10 (all of the claims now standing) in the above-identified application.

(1) Real Party In Interest

Applicant's Assignee, Ultrafab, Inc., of Farmington, New York, is the Real Party In Interest in this case.

(2) Related Appeals and Interferences

There are no Appeals or Interferences related to this Appeal or to this application.

(3) Status of Claims

Claims 1-10 are pending and all of these claims are forwarded for consideration on this Appeal.

(4) Status of Amendments

A Response was filed on February 11, 2003 to the Final Rejection of January 23, 2003. The claims were not amended in this Response. The Response contains reasons,

both factual and legal, supporting the allowance of the claims which were finally rejected and are now on appeal.

In an Advisory Action dated March 5, 2003, the Examiner maintained his Final Rejection stating, "the claims still read on the art of record".

On or about March 10, 2003, Counsel contacted the Examiner and attempted to ascertain the basis of the Examiner's statement in the Advisory Action. No cognizant reasons were solicited thereby predicated this Appeal.

(5) Summary of Invention

This invention relates to weather seals for sealing body parts such as windows, doors and trunks of automotive vehicles (cars and trucks) (page 1, first paragraph). The invention has two aspects. The first deals with the encapsulation of the core (the wire carrier 12, FIGS. 2 and 3) with a substrate or encapsulating filler 20 of recycled elastomeric material which is then covered with virgin elastomeric material (paragraph bridging pages 2 and 3, FIGS. 2 and 3, fourth full paragraph on page 6). Preferably, as shown in FIGS. 3 and 4, the substrate is applied as tape; preferably extruded as molten tapes 30 and 32 sandwiching the core or carrier 12 and its reinforcing elements 14 (paragraph bridging pages 6 and 7 and first full paragraph on page 7).

The principal advantage of the use of the substrate is to reduce the cost of the weather seal. Other advantages are to improve the integrity of the weather seal. These advantages are spelled out from lines 5-25 on page 3.

The second aspect of the invention is to provide a core and carrier which avoids the need for reinforcement elements of knitted yarn (paragraph bridging pages 3 and 4). These reinforcement elements 42 are laid down only on one side of the core (the loops of the carrier 12) (page 7, lines 16 and 17). The core 12 is carried around a wheel 56 and the plurality of reinforcing elements 90 are fed onto one side of the elements on the wheel. The elements are attached to the core at a processing station 80 (FIG. 8A) as by glue from a dispenser 84 (see FIG. 11). The substrate and sealing layers are then applied over the core and the reinforcing elements (the summary and last full paragraph on page 4, and first full paragraph on page 8).

(6) Issues

The only issue presented by the Final Rejection is whether any of the claims are anticipated by Weichman, U.S. Patent No. 4,517,233, under 35 U.S.C. §102(b).

(7) Grouping of Claims

The first aspect of the invention is set forth in Claims 1-4 and 8. An important feature of the invention is to provide the substrate of recycled elastomeric material in the form of a tape or tapes which encapsulate the core and this aspect is in Claims 3, 4 and 8. Another group of claims is 5-7, 9 and 10. These are product by process claims which define the weather seal in terms of the use of a wheel to carry the core and define a space where the reinforcing elements are applied, the nature of these elements and the process by which they are attached, namely application of adhesive, fusion bonding, or encapsulation.

With respect to the 35 U.S.C. §102(b) rejection, the claims do not stand or fall together, and are in three claims groups:

Group I - Claims 1 and 2;

Group II - Claims 3, 4 and 8; and

Group III - Claims 5-7, 9 and 10.

(8) Argument

It is respectfully submitted that the only rejection of the claims in this case as being anticipated by Weichman, U.S. Patent No. 4,517,233, should be reversed.

Weichman shows a core or carrier made up of two distinct loops 16 and 18 which are held together by interweaving the loops with yarn-type reinforcing elements (column 3, lines 45-63). This core is coated with an elastomeric material 36, which is shown as a single coating of one body of material.

Claims 1 and 2 are not met because the element of the weather seal, a substrate of recycled elastomeric material encapsulating the core and a covering of virgin elastomeric material providing a sealing surface are both not shown in any form equivalent or otherwise in Weichman.

The use of tape or tapes of the recycled material as the substrate as set forth in Claims 3, 4 and 8 is also and similarly not shown or apparent from Weichman, and thus such claims are separately patentable from other claims on Appeal.

Nothing is disclosed in Weichman as to the use of a wheel for carrying a weather seal core and applying reinforcing elements to one side of the core as the wheel rotates. The inner sinus wire 18 of the Weichman core is not a reinforcing element. If it were, the yarn 42 would not be required. It is the yarn which is the only reinforcing element in Weichman, and that yarn is woven around the turns of the sinus wires 16 and 18. Claim 5 defines a weather seal made by applying reinforcing elements along only one side of a core. This limitation also distinguishes over Weichman. Claim 5 and dependent Claims 6-7 and 9-10 are separately patentable from other claims on Appeal by describing the applying and attaching of reinforcing elements not present in Weichman.

Since each and every element of the claims are not found in Weichman, Weichman does not anticipate the invention as claimed under 35 U.S.C. §102(b). See Applied Med. Resources Corp. v. United States Surgical Corp., 147 F.3d 1374,1378 (Fed. Cir. 1998) and United States Filter Corp. v. Ionics, Inc., 68 F. Supp. 2d, 48,52 (D. Mass.) 1999.

The law does not permit an interpretation of Weichman on which anticipation can be based. A patent claim is anticipated only if a comparison of the claimed invention with a single prior art reference establishes clearly and convincingly that every element in the claim is "described, organized, and functioning in substantially the same manner as in the prior art reference." Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989, 996 (Fed. Cir. 2000) (affirming jury finding of no anticipation); Biacore, AB v. Thermo Bioanalysis Corp., 79 F. Supp. 2d 422, 459 (D. Del. 1999) (finding patent not anticipated and infringed).

Whether a specific reference anticipates a patent claim "is a question of fact." Rockwell Intern. Corp. v. U.S., 147 F.3d 1358, 1363 (Fed. Cir. 1998). To establish a *prima facie* case of anticipation, the Examiner must prove, therefore, with respect to the claims, that a single prior art reference describes all of the claimed subject matter in its entirety. That description in the prior art reference must contain sufficient detail and clarity to demonstrate that the claimed subject matter existed prior to the invention, and

that a person of ordinary skill in the art would have recognized its existence in the proffered prior art reference. See Helifix Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339, 1346-47 (Fed. Cir. 2000) (vacating grant of summary judgment of invalidity by anticipation).

Accordingly, there is no anticipation by Weichman. With all due respect, the Examiner has ignored salient limitations in the claims which provide significant improvements in weather seals of the type having wire and similar cores, including Weichman's, all as explained in the specification.

It is further respectfully submitted that general references involving the use of recycled elastomeric material (rubber) are not analogous to the invention as claimed and would not support a rejection under 35 U.S.C. §103. Such a rejection would not constitute a *prima facie* case of obviousness. See In re Rijckaert, 9 F. 3d 1531,1532, 28 U.S.P.Q. 2d, 1955, 1956 (Fed. Cir. 1993). In any event, such a general reference would not constitute evidence that would lead one of ordinary skill in the art to combine the teachings thereof with Weichman, to arrive at the claimed invention. See In re Fine, 837 F.2d 1071,1074, 5 U.S.P.Q. 2d, 1596,1598 (Fed. Cir. 1988) and In re Lintner, 458 F. 2d 1013,1016, 173 U.S.P.Q. 560,562 (CCPA 1972).

For the foregoing reasons, the decision of the Examiner finally rejecting Applicant's claims should be reversed and the Examiner should be directed to pass this case to Issue.

Respectfully submitted,



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Dated: April 23, 2003

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APPENDIX
Claims On Appeal

1. A weather seal comprising a core, a substrate of recycled elastomeric material encapsulating said core, a covering of virgin elastomeric material providing a sealing surface and encapsulating said core and substrate.

2. The weather seal according to Claim 1 where the core is a wire loop carrier.

3. The weather seal according to Claim 1 wherein the recycled material is cured EPDM or TPR which is applied in molten or semi-molten form as a tape or tapes.

4. The weather seal according to Claim 3 wherein the material is extruded to form said tape or tapes.

5. A weather seal comprising a core, longitudinal extension control and reinforcing elements applied along only one side of said core by carrying said core around a wheel which exposes a space thereof, applying said element through said space as said wheel rotates, and attaching said elements to said core in said space after application.

6. The weather seal according to Claim 5 wherein said core is a wire loop carrier and elements are yarns, selected from the group consisting of polyester strands, fiberglass strands, metal wires and monofilaments.

7. The weather seal according to Claim 6 wherein said attaching step is carried out by chemical bonding, with adhesive applied where said elements contact the core.

8. The weather seal of Claim 3, further comprising one or more reinforcement elements adjacent to and along the length of said core on only one side

thereof, said tape encapsulating said core and attaching said reinforcement elements to said core.

9. The weather seal of Claim 6 wherein said attaching step is carried out by fusion bonding.

10. The weather seal of Claim 6 wherein said attaching step is carried out by encapsulation of said elements and said core.